LIBRARY
SUPREME COURT, U. S.

Office Supreme Court, U.S.
FILED
JUL 3 1963
JOHN F. DAVIS, CLERK

# In the Supreme Court of the United States

No. 252

OCTOBER TERM, 1963.

HARRY A. TOULMIN, JR.,
*Petitioner,*

vs.

THE RIKE-KUMLER COMPANY and
MIAMI VALLEY NEWS AGENCY, INC.,
*Respondents.*

## PETITION FOR A WRIT OF CERTIORARI
To the United States Court of Appeals
For the Sixth Circuit.

H. A. TOULMIN, JR.,
*Petitioner,*
Of the firm,
TOULMIN & TOULMIN,
11 South Wilkinson St.,
Dayton 2, Ohio.

THE GATES LEGAL PUBLISHING CO., CLEVELAND, OHIO—MAIN 1-5647

## TABLE OF CONTENTS.


Opinions Below ..... 1

Jurisdiction ..... 1

Questions Presented ..... 2

Statutes Involved ..... 5

Statement of the Case ..... 5

Appendices:

A. Findings and Judgment of the District Court 8

B. Order of the United States Court of Appeals for the Sixth Circuit ..... 13

C. 28 U. S. C. A. 1254 (1), (2), (3) and (6) ..... 14

D. 17 U. S. C. A. 101 ..... 16


## TABLE OF AUTHORITIES.

### Cases.


*Parris vs. Hexamer*, 99 U. S. 674 (1878) ..... 3


### Statutes.


17 U. S. C. A. 1 ..... 5

17 U. S. C. A. 101 ..... 2, 5, 16

28 U. S. C. A. 1254(1), (2), (3) and (6) ..... 1, 14

# In the Supreme Court of the United States

No. _____

OCTOBER TERM, 1963.

---

HARRY A. TOULMIN, JR.,

*Petitioner,*

vs.

THE RIKE-KUMLER COMPANY and
MIAMI VALLEY NEWS AGENCY, INC.,

*Respondents.*

---

## PETITION FOR A WRIT OF CERTIORARI
## To the United States Court of Appeals
## For the Sixth Circuit.

---

Harry A. Toulmin, Jr., your petitioner, prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Sixth Circuit, entered in the above entitled case on April 17, 1963.

## OPINIONS BELOW.

The opinions of the District Court and Court of Appeals are attached as Appendices A and B respectively.

## JURISDICTION.

The judgment of the Court of Appeals was entered on April 17, 1963. The jurisdiction of this Court is invoked under the provision of 28 U. S. C. A. Para. 1254(1), (2), (3) and (6). (Set forth in Appendix C at page 14, *infra.*)

## QUESTIONS PRESENTED.

1. Whether the deliberate copying of a part of a copyrighted book, for the purpose of lending an air of authenticity to the copier's book, constitutes an infringement of the copyright.

2. As to whether material copied from a copyrighted book, regardless of the amount, large or small, but admittedly of considerable importance in setting the background of the accused novel comes within the infringement provision of 17 U. S. C. A. Sec. 101 of the Copyright Law as set forth in Appendix D.

3. Does the doctrine of "fair usage" lend protection to a deliberate purloiner of copyrighted material who admittedly copied for the sole purpose of "lending an air of authenticity" to his own popular and fictional novel?

4. Whether, where there is a deliberate and intentional infringement of a valid and subsisting copyright and the owner of the infringed copyright is unable to prove actual damages, and the copyrighted book has been out of print for a number of years at the time of infringement, can the infringement be justified as being within the legal maxim "De minimis non curat lex"?

5. Is it necessary for a copyright owner, in order to prevail, to demonstrate actual damages as a result of the usurpment of his copyrighted material? Does not 17 U. S. C. A. 101(b) (set forth in Appendix D) provide for maximum statutory damages of $250.00 where no actual damage can be shown?

The above issues are of singular importance to copyright owners, also the public, and have not been settled by earlier decisions either by this Court or by the lower Courts. The decisions below have been based on the legal fictions of "de minimis" and "fair usage" which, to date,

have been subjected to various interpretations, leaving it entirely to the personal judgment of the Courts below as to the *amount* of material that must be copied to constitute infringement.

The Courts, even though attempting to be fair and impartial, have no yardstick or authoritative rules to go by to protect the copyright owner and at the same time to allow an accused party's use of his independently acquired information. The Courts rely solely upon their personal opinion which renders the copyright infringement law unpredictable, and in some cases, as meaningless.

The absolute effect of the copied material even when relatively small in quantity, on the prospective buyer of the book, and therefore the loss of sales and protection to the copyright owner, has seldom if ever, been duly considered by the Courts below, much less legally evaluated by them. The legal emphasis has been on *quantity*—not on *quality*, or *significance of the copied material*, which might affect the desirability for the book far more than the amount, however large, of the purloined material.

There have been few, if any, decisions of the high Court on the subject of copyright infringement, since the very old case of *Parris vs. Hexamer*, 99 U. S. 674 (1878) which seems to have been decided mainly on the basis of *quantity*, and *not* on the *commercial significance* of the material copied. In the present case, the importance of the copied material was actually admitted by the infringer, and even though small in quantity, it nevertheless was instrumental in giving an authoritative semi-historical background to the infringer's book as a whole.

We believe a final decision in this case initiated by this Request for Certiorari will assist in clarifying the rights of copyright owners against those who knowingly and cleverly usurp ideas expressed in the words of an-

other, even though the latter is of few word content but still serves to leaven the entire content of an accused book.

The Courts below held that the material taken from petitioner's book was both "fair use" and also, was a case of "de minimis." But these terms are *inconsistent* with one another, in that "fair use" does not presuppose that the matter was copied or adopted but only that the *underlying idea* was used. On the other hand, "de minimis" is based upon actual copying of the material, but that the amount is *too small* for the law to take notice. In the case in issue, the material copied was practically word for word of the copyrighted material so that the only issue should have been one of "de minimis,"—not of "fair use."

Your petitioner makes this point to show that the present case. if certiorari be granted, will allow this Court an opportunity to clarify, and give authoritative weight to the precise differences in the application of the "de minimis" and "fair use" theories for the guidance of the Courts below and the practitioners in those Court. Your petitioner would also have the opportunity to show that the *quantity* of material copied is only *one* of the basic factors that must be considered in the matter of copyright infringement, and the *qualitative content* of the copied material, in terms of setting the background of an infringing novel and other qualifying characteristic must also be considered. The latter may even predominate over any consideration of quantity of the copied material, great or small. The effect under the "de minimis" theory of the copied material on a novel or book as a whole, i.e. as to whether this material would permeate or carry through the book, even though small in actual quantity, must receive the attention of the legal tribunals in order to protect the rights of the copyright owner under the copyright infringement statutes.

## STATUTES INVOLVED.

The statutes involved are the copyright laws of the United States, the pertinent portions of which are: 17 U. S. C. Para. 1 and 17 U. S. C. Para. 101. These sections are set forth in Appendix D at page 16, *infra*.

## STATEMENT OF THE CASE.

Petitioner, in 1935, authored a book, called *With Pershing in Mexico*, which was in that same year copyrighted and published by The Military Service Publishing Company. The book underwent but one publication and was sold out within a year or two after being introduced on the market.

In 1958, a book called *They Came to Cordura*, written by Glendon Swarthout, was published by Random House Inc. in a hard cover edition and the following year the same book was published in a paperback edition by The New American Library of World Literature, Inc. The paperback edition was distributed in the Dayton, Ohio area by respondent, Miami Valley News Agency, Inc. Both the hard cover edition and the paper back edition were sold at retail to the public by respondent, The Rike-Kumler Company. These sales were made during the years 1958 and 1959.

In 1959, petitioner received an assignment of the copyright covering the book *With Pershing in Mexico*, which was duly recorded with the Copyright Office.

In February 1960 this action was initiated by petitioner against respondents in the Federal District Court in Dayton, Ohio, charging respondents with infringement of the subsisting copyright on the book *With Pershing in Mexico*.

In the beginning of Chapter Two, entitled "The Terrain," of petitioner's book, there is the following paragraph:

> *"If God had set out to mold a country as a stage for a cavalry campaign, he would have made* the plains, the streams, the ranches and mountains of Chihauhau —barren wastes, green oases, sterile sand, mud, magnificent mountains, mean adobe villages, fertile ranches and rich mines. All the grandeur of poverty, the misery of politics and the fury of Latin passions—that is Mexico. It was upon this enormous stage of the plains against the back drop of the Sierra Madre mountains that Pershing and Villa played their game of hide and seek. *This was a state five hundred miles long and a hundred miles wide across which snow, sandstorms, tropic heat and sharp cold added to the misery of the actors."*

In the foreword to the accused book, *They Came to Cordura*, sold by respondent, the italicized portions of the above quoted paragraph are set forth. In his testimony at the trial, the author of *Cordura*, Glendon Swarthout, admitted that he copied the passage in question from petitioner's copyright book, practically word for word, in order to lend an air of authenticity to the *Cordura* book. Without this air of authenticity, there is doubt as to whether *Cordura* would have sold in the quantities that it did, if at all. The Trial Court adopted this admission as one of its findings of fact.

Swarthout further testified, (a) a novel such as *Cordura* must have its stage upon which the story is presented, and that stage is set in the foreword; (b) the description of the terrain was the stage for the story in *Cordura*; (c) the passage taken from petitioner's book provided the backdrop for that stage.

In spite of these admissions by respondents' witness, the Trial Court held that the copying of that portion of petitioner's book was a "fair usage" thereof and that since the petitioner failed to show any actual damages as a result of the copying, the case was one of "de minimis." As we have pointed out, "fair usage" and "de minimis" are inconsistent with one another and not well understood by Courts or the practitioners therein, in the absence of authoritative direction by the high Court. The Trial Court entered judgment in favor of the respondents and against the petitioner on both of these grounds.

On appeal, the Court of Appeals affirmed the judgment of the Trial Court without additional reason or comment.

Respectfully submitted,

H. A. TOULMIN, JR.,
*Petitioner,*

Of the firm,
TOULMIN & TOULMIN,
Dayton, Ohio.

*Of Counsel:*

FOLSOM E. DRUMMOND,
TOULMIN & TOULMIN,
1248 Pennsylvania Ave.,
Washington, D. C.,

H. A. TOULMIN, JR.,
TOULMIN & TOULMIN,
11 South Wilkinson St.,
Dayton 2, Ohio,

H. H. BROWN,
TOULMIN & TOULMIN,
11 South Wilkinson St.,
Dayton, Ohio.

## APPENDIX A.

### Findings and Judgment of the District Court.

(Civil Action No. 2442—Caption Omitted.)

(Filed June 30, 1962.)

1. Harry A. Toulmin, Jr., is the author of the book "With Pershing in Mexico," hereinafter referred to as "Pershing," published and copyrighted in 1935 by The Military Service Publishing Company of Harrisburg, Pennsylvania.

2. There was only a single printing of the "Pershing" book. The book has been out of print since 1936. There have never been any plans or intentions to republish or reprint the book.

3. The "Pershing" book is a factual account of the Punitive Expedition against Pancho Villa in the Mexican Province of Chihuahua in 1916 under the command of General John J. Pershing following a raid by Villa on the border town of Columbus, New Mexico. It is in no sense a novel.

4. The book alleged to infringe is "They Came to Cordura," hereinafter referred to as "Cordura," written by Dr. Glendon Swarthout of Scottsdale, Arizona. It was published by Random House of New York in a hard cover edition in 1958, and by The New American Library of World Literature of New York in a paper edition in 1959. These three parties are not residents of this District and were dismissed as parties defendant.

5. The paper back edition was distributed in the Dayton area by defendant, The Miami Valley News Agency, Inc. Both the hard cover edition and the paper back edition were sold at retail to the public by the defendant, The Rike-Kumler Company.

6. The total number of paper back copies of "Cordura" distributed by defendant, The Miami Valley News Agency, Inc., was less than 600 of which no more than 20 were sold by defendant, The Rike-Kumler Company. Less than 20 copies of the hard cover edition were sold by the Rike-Kumler Company. Defendants had no copies of the "Cordura" book on hand or for sale at the time of the trial, and had been out of such stock and had made no sales thereof for more than a year prior thereto. There were no plans by either company to sell or stock the book again.

7. No notice of infringement was given to either defendant, and the first knowledge The Rike-Kumler Company had of the claim was a newspaper story reporting the filing of this suit.

8. The "Cordura" book is a novel with a historical setting. Its Foreword states:

> "This is not a book about Villa. The characters, except for General Pershing and a newspaper correspondent who appears briefly, are imagined. The designations of military units have been altered. It is a book about certain minor fictitious events before and after the lost, last charge at Ojos Azules, which means Blue Eyes."

Its time and setting are those of the last cavalry charge of the Mexican campaign and, starting from that point, it is the story of an imaginary trip made by a fictitious group of prisoners including a woman through difficult and barren country on a perilous journey back to civilization. The description of the cavalry engagement is based on fact and the description of the terrain through which the journey was made is also factual, the outgrowth of a trip made to the area by Swarthout for the purpose of becoming acquainted with the territory preparatory to writing

about it. In all other respects, the characters, the story and the action are fictitious.

9. In the Foreword to "Cordura," there is a quotation consisting of a portion of the first sentence and the last sentence of one paragraph found in the "Pershing" book. The "Pershing" book contains 10 chapters, 142 pages in all, Chapter 2 containing the quoted portion. This chapter comprises 8 and ½ printed pages of which the quoted sentences occupy about a seventh of one page.

10. The charge of alleged infringement is based on the following passage appearing in the Foreword of "Cordura":

> "Of the terrain, one officer, writing twenty years later, concluded that 'If God had set out to mold a country as a stage for a cavalry campaign, he would have made * * * Chihuahua * * *. This was a stage five hundred miles long and a hundred miles wide across which snow, sandstorms, tropic heat and sharp cold added to the misery of the actors."

11. Glendon Swarthout had served on an awards commission while with the U. S. Army in Italy in World War II. He was seeking a basis for writing a story involving that experience and happened to come across an account of the Mexican Campaign under Pershing against Pancho Villa.

12. In researching in the library at the Michigan State University, where he was then teaching, to find source materials to use as a background for "Cordura," Swarthout found only two books that had ever been written on the Mexican Punitive Expedition. One was a comprehensive and authoritative source by a cavalry officer who had personally taken part in the campaign, namely, "Chasing Villa" by Colonel Frank Tompkins, copyrighted 1934 by The Military Service Publishing Company of

Harrisburg, Pennsylvania. The other was the "Pershing" or Toulmin book.

13. In studying background material, Swarthout made liberal use of Tompkin's book and the "Cavalry Journal," published by The American Cavalry Association. He found contemporary issues of that Journal especially valuable because they contained detailed reports from officers who were then taking part in the campaign.

14. Swarthout used quoted material from both the Tompkins book and the "Cavalry Journal" and from other sources, the quotes varying in length from a few words to a paragraph or more.

15. Swarthout also read the Toulmin book while he was writing "Cordura." He considered it a secondary source because Toulmin had not personally been present or taken part in the campaign.

16. Swarthout selected these two sentences and quoted them, stating that "one officer, writing twenty years later, concluded that * * *" in order to lend an air of authenticity to his book.

17. In the "Pershing" book, Toulmin followed the same pattern as Swarthout as to quoting from an unidentified cavalry officer. At page 47, he used a quotation from an officer identified only by the phrase "as one officer expressed it * * *."

18. The use of one sentence and a part of another by Swarthout in "Cordura" taken from "Pershing," represents neither a substantial nor material part of the latter, was insignificant in value and extent of the copyrighted material, did not in any degree prejudice the sale, diminish the profits or supersede the objects of the original work, and was thus a "fair use" thereof.

19. The sentences used had no effect whatsoever on the acceptance or sale of the "Cordura" book. Toulmin was not, and could not have been, damaged in any way by the publication of "Cordura."

20. The sentences used in "Cordura" are not the heart and core of the entire theme of the Toulmin book; they do not in fact relate to that theme at all.

21. The clear facts and the only possible inferences than can reasonably be drawn from them establish beyond possibility that this case is a clear case of de minimis.

22. Since the "Pershing" book had been out of print for at least 22 years before "Cordura" was published, there was not and could not have been any unfair competition or unfair trade practice with plaintiff as alleged in the Complaint.

## JUDGMENT.

Judgment is therefore entered in favor of the defendants and against the plaintiff herein and costs are assessed against the plaintiff. The matter of assessment of reasonable atttorney fees as prayed for in the complaint is continued until further order of the Court.

/s/ WEINMAN, J.,
*Chief Judge U. S. District Court.*

Journal entry not required.

## APPENDIX B.

### Order of the United States Court of Appeals for the Sixth Circuit.

(Filed April 17, 1963.)

(Caption Omitted.)

BEFORE: MILLER and O'SULLIVAN, Circuit Judges, and McALLISTER, Senior Circuit Judge.

In this action charging the defendants with violation of the plaintiff's copyright, in that the defendants published a book by a different author which contained a deliberate copy of a sentence and a half from plaintiff's copyrighted book of 142 pages which has been out of print since 1936, with no plans or intentions at any time to republish or reprint the book, the District Judge was of the opinion, among other things, that this was a clear case of de minimis and entered judgment for the defendants.

IT IS ORDERED that the judgment be affirmed with costs assessed against the appellant.

Approved for entry:

/s/ SHACKELFORD MILLER, JR.,

*United States Circuit Judge*

## APPENDIX C.

(Referred to on page 1 of the Petition.)

Title 28 U. S. C. A. Para. 1254(1) reads:

"Prior Law—Except as was provided in Act Mar. 3, 1891, ch. 517, Para. 6, 26 Stat. 828, certiorari could not be made to serve the purpose of an appeal or writ of error. * * *"

Title 28 U. S. C. A. Para. 1254(2):

"Purpose—'In order to guard against any injurious results which might flow from having nine appellate courts, acting independently of each other, power was given to this court to bring before it for decisions by those courts. In that way it was believed that uniformity of ruling might be secured, as well as the disposition of cases whose gravity and importance rendered the action of the tribunal of last resort peculiarly desirable.' Warner v. New Orleans, 1897, 17 S. Ct. 892, 167 U. S. 467, 42 L. Ed. 239.

"Prior to 1925 the jurisdiction conferred on the Supreme Court to review decrees of the Circuit Court of Appeals on certiorari was not conferred merely to give the defeated party another hearing, but to secure uniformity of decision and to bring up cases of importance, which it is in the public interest to have decided by the court of last resort. Magnum Import Co. v. Coty, N. Y. 1923, 43 S. Ct. 531, 262 U. S. 159, 67 L. Ed. 922. See, also, Columbus Watch Co. v. Robbins, Ohio 1893, 13 S. Ct. 594, 148 U. S. 266, 37 L. Ed. 445."

Title 28 U. S. C. A. Para. 1254(3):

"Amendment of 1925—The great purpose of the 1925 amendment to former section 347 of this title was to curtail the Supreme Court's obligatory jurisdiction by substituting, for the appeal as of right, discretionary review by

certiorari in many classes of cases. Ex parte Republic of Peru, La. 1943, 63 S. Ct. 793, 318 U. S. 578, 87 L. Ed. 1014."

Title 28 U. S. C. A. Para. 1254(6):

"To whom application made—Application for writ of certiorari must be made to Supreme Court, but application for stay should be made in first instance to Circuit Court of Appeals. Nelson v. Lewis, D. C. N. Y. 1935, 9 F. Supp. 406.

"Application for certiorari must be made to the court while in session. The Conqueror, N. Y. 1897, 17 S. Ct. 510, 166 U. S. 110, 41 L. Ed. 937."

## APPENDIX D.

Title 17 U. S. C. A. Para. 1 reads:

"Exclusive rights as to copyrighted works—Any person entitled thereto, upon complying with the provisions of this title, shall have the exclusive right:

(a) To print, reprint, publish, copy, and vend the copyrighted work;"

Title 17 U. S. C. A. Sec. 101 reads:

"Infringement—If any person shall infringe the copyright in any work protected under the copyright laws of the United States such person shall be liable:

(a) Injunction.—To an injunction restraining such infringement;

(b) Damages and profits; amount; other remedies.—To pay to the copyright proprietor such damages as the copyright proprietor may have suffered due to the infringement, as well as all the profits which the infringer shall have made from such infringement, and in proving profits the plaintiff shall be required to prove sales only, and the defendant shall be required to prove every element of cost which he claims or in lieu of actual damages and profits, such damages as to the court shall appear to be just, and in assessing such damages the court may, in its discretion allow the amounts as hereinafter stated, but in case of a newspaper reproduction of a copyrighted photograph, such damages shall not exceed the sum of $200 nor be less than the sum of $50, and in the case of the infringement of an undramatized or nondramatic work by means of motion pictures, where the infringer shall show that he was not aware that he was infringing, and that such infringement could not have been reasonably foreseen, such damages shall not exceed the sum of $100; and in the case of an

infringement of a copyrighted dramatic or dramatico-musical work by a maker of motion pictures and his agencies for distribution thereof to exhibitors, where such infringer shows that he was not aware that he was infringing a copyrighted work, and that such infringements could not reasonably have been foreseen, the entire sum of such infringing motion picture shall not exceed the sum of $5,000 nor be less than $250, and such damages shall in no other case exceed the sum of $5,000 nor be less than the sum of $250, and shall not be regarded as a penalty. But the foregoing exceptions shall not deprive the copyright proprietor of any other remedy given him under this law, nor shall the limitations as to the amount of recovery apply to infringements occurring after the actual notice to a defendant, either by service of process in a suit or other written notice served upon him."

Office Supreme Court, U.S.
FILED
AUG 21 1963
JOHN F. DAVIS, CLERK

No. 252

In the

# Supreme Court of the United States

October Term, 1963

HARRY A. TOULMIN, JR.,
Petitioner,

vs.

THE RIKE-KUMLER COMPANY and
MIAMI VALLEY NEWS AGENCY, INC.,
Respondents.

## RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR CERTIORARI

LAWRENCE B. BIEBEL.
Attorney for Respondents.

OF COUNSEL:
MARECHAL, BIEBEL, FRENCH & BUGG
DAILEY L. BUGG
Winters Bank Building
Dayton 2, Ohio

Court Index Press, Inc. — Law Printers — 809 Walnut St., Cincinnati 2, Ohio

# INDEX


| | Page |
|---|---|
| Counter-Statement of Questions Presented | 1 |
| Respondents' Statement of the Case | 2 |
| Argument | 7 |
| Conclusion | 9 |


## CITATIONS

No citations appear in the body of the Brief.

The authorities cited to the Courts below are set out in Appendices I and II ..... 10, 13

In the

# Supreme Court of the United States

No. 252

---

October Term, 1963

---

HARRY A. TOULMIN, JR.,
Petitioner,

vs.

THE RIKE-KUMLER COMPANY and
MIAMI VALLEY NEWS AGENCY, INC.,
Respondents.

---

## RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR CERTIORARI

The Petition for Certiorari is believed to be so clearly without substance on the merits, and to fall so far short of the requirements of Rule 19 of this Court, that respondents will confine themselves to the following Counter-statement of Questions Presented and brief recital of facts not furnished, or only partially furnished, to the Court in the Petition.

## COUNTER-STATEMENT OF QUESTIONS PRESENTED

I. Is the acknowledged quotation of a sentence and a half from a historical account in the Foreword of a novel

set against the background of the historical event a fair use where:

a. The material quoted was neither a substantial nor material part of the copyrighted work and did not in any degree prejudice the sale, diminish the profits or supersede the objects of the original work;
b. Such material had no effect whatsoever on the acceptance or sale of the accused novel; and
c. Plaintiff himself had followed in the copyrighted historical work the same pattern of acknowledged quotation which he charges as copyright infringement by the author here.

II. Is the charge of copyright infringement *de minimis* under the circumstances of Question I, where:

a. The copyrighted work had been out of print for some 22 years and there were and are no plans to republish it;
b. Plaintiff knew and stated that interest in the work had long since been exhausted;
c. The quotation was not charged as copyright infringement by the then owner of the copyright;
d. Plaintiff procured a purported assignment of the copyright without consideration and on representations that he wanted it for sentimental reasons; and
e. The total retail value of the copies sold by defendants was less than $400.00.

## RESPONDENTS' STATEMENT OF THE CASE

The words charged as an infringement appear as an acknowledged quotation in the Foreword to a novel, *They Came To Cordura*, written by Glendon Swarthout and having the historical background of General Pershing's 1916

Punitive Expedition into Mexico against Pancho Villa. The book has nothing to do with either Pershing or Villa, except that the imaginary events of the novel are related as having occurred during the campaign. The book was published in a hard-cover edition in 1958 by Random House, Inc., and a paper-back reprint in 1959 by New American Library, both of New York City. The excerpt in the Petition is insufficient to show that Swarthout was clearly quoting what Swarthout wrote is:

> "Of the terrain, one officer, writing twenty years later, concluded that 'If God had set out to mold a country as a stage for a cavalry campaign, he would have made . . . Chihuahua. This was a stage five hundred miles long and a hundred miles wide, across which snow, sandstorms, tropic heat and sharp cold added to the misery of the actors.'" (Foreword to both Ptf's Ex. F (phys.) and Dft's Ex. 6 (phys.) (Page at which offered not printed. Fdg 10, Petit. p. 10))*

The quoted words are from a historical account of the Expedition written by Toulmin entitled *With Pershing In Mexico*, and which is concerned wholly with Villa and Pershing's Expedition. A single edition of the book was published in 1935 by Military Service Publishing Company of Harrisburg, Pennsylvania, and quickly went out of print. There were not and have never been plans or intentions to republish or reprint it and, in Toulmin's words, ". . . interest in it has long since been exhausted and there are no more copies . . . available". (Fdg. 2, Petit. p. 8; Dfts' Ex. 4, Appdx. 22b, 41b).

---

* References to physical exhibits are identified by their exhibit numbers at the trial, to those portions of proceedings below included as Appendices to the Petition for Certiorari by page number in the Petition, and to the portions of proceedings below not reproduced in the Petition but appearing in ptf's Appendix to the Court of Appeals, by the Appendix page numbers followed by "a", and in dfts' Appendix to the Court of Appeals by the Appendix page numbers followed by "b".

The pertinent text of the Toulmin book appears at page 6 of the Petition and is repeated here for convenience. The parts used in *Cordura* are in italics:

> "*If God had set out to mold a country as a stage for a cavalry campaign, he would have made* the plains, the streams, the ranches and mountains of *Chihuahua*—barren wastes, green oases, sterile sand, mud; magnificent mountains, mean adobe villages, fertile ranches and rich mines. All the grandeur of poverty, the misery of politics and the fury of Latin passions—that is Mexico. It was upon this enormous stage of the plains against the back drop of the Sierra Madre mountains that Pershing and Villa played their game of hide and seek. *This was a stage five hundred miles long and a hundred miles wide across which snow, sandstorms, tropic heat and sharp cold added to the misery of the actors.*" (Ptfs. Ex. E (phys.) p. 17; see Appd. p. 15b).

Thus more was omitted than was quoted. The District Court found the quoted portion to be insignificant in value and extent of the work from which quoted, and neither a substantial nor material part of it. Correspondingly, the Court found that the quotation did not affect acceptance or sale of the novel (Fdgs. 18-21, Petit. pp. 11-12.)

In the historical account, Toulmin himself had followed exactly the same pattern which is the sole basis of his present charge of copyright infringement against *Cordura*, stating at page 47 of such account that:

> ". . . the swiftly moving panorama of this campaign, which was, as one officer expressed it (followed by a longer quotation than the words quoted from *Pershing*)" Ptfs Ex. E (phys.) p. 47; Fdg. 17, Petit. p. 11, page at which offered not printed.)

Thus in writing his own book, Toulmin recognized and followed the widely accepted practice of quoting briefly

from earlier works on historical and factual matters, but charges infringement when this same practice was followed by another. Our position is not that infringement by one justifies infringement by another, but that use of this kind is a common practice, not infringement, and that Toulmin so recognized it in following the practice himself.

When *Cordura* was published, Toulmin did not own the copyright on *Pershing*. It was owned by the original publisher, Military Service Publishing Company. That company did not then, or ever, advance any claim of alleged infringement. Toulmin, however, following publication of both editions of *Cordura*, obtained a purported assignment of the copyright, without consideration, as a result of the following representations in a letter which he wrote Military Service:

> "For sentimental reasons, I would like very much to have the assignment by you to me, of the copyright on ('*With Pershing in Mexico*'). I presume that the interest in it has long since been exhausted and there are no more copies of this book available." (Dfts. Ex. 4, Apdx. 22b-23b, 41b).

This assignment was no more than colorable because it was not by Military Service, but by The Stackpole Company, Inc. Plaintiff made no attempt in the trial record to connect Stackpole with Military Service; thus there is a complete failure of title in plaintiff to maintain the action.

The Courts below found on the merits that the situation constituted a clear case of of (1) fair use, and (2) *de minimis*, without necessity for reaching the question of title. (Distr. Ct. Fdgs. 18-21, Petit., pp. 11, 12; Ct. Ap. Dec., Petit., p. 13). Thus the question so emphasized by plaintiff in the Petition as to an alleged right to minimum damages under 17 U.S.C.A. 101(b) is not present in the case. Damages do

not follow from bringing suit, but only from establishing infringement. Plaintiff recognized this in the Courts below and never raised the question in the District Court or in its Notice of Appeal, or even in its Main Brief on appeal.*

In the assignment obtained ostensibly "for sentimental reasons," which Toulmin prepared, he included the right to sue for past infringement. Promptly upon obtaining it, he filed the Complaint herein, and did so without giving notice of alleged infringement; defendant Rike-Kumler, the leading department store in Dayton, Ohio, learned of the suit from a newspaper account. (Fdg. 9; Petit. p. 9; Appd. 6b). Miami Valley News is a distributor of paperback books for the area. Both defendants are local Dayton organizations.

At the time of trial neither defendant had had a copy of *Cordura* for more than a year and had no intention of further sales of the book, and there have been none. Their total sales were less than 20 copies of the hard-cover edition, and 600 of the paper-bound edition, with a total retail value of under $400. (Appd. 5b-6b, 8b; Fdg. 6, Petit. p. 9).

The District Court, after a full trial, found that the sentence and a half from *Pershing* quoted some 22 years later by Swarthout in *Cordura* was "neither a substantial nor material part of (*Pershing*)", that it was "insignificant in value and extent of the copyrighted material", and further that it "did not in any degree prejudice the sale, diminish the profits or supersede the objects of" the original historical account. The evidence completely supports the findings and there is no contrary evidence. On this basis the Court held the quotation to be a "fair use". (Fdgs. 18; Petit. p. 11).

---

* The earliest reference to 17 U.S.C.A. 101(b) in the suit was in plaintiff's reply brief to the Court of Appeals and was characterized by that Court during oral argument as "an afterthought".

Equally significant, having in mind that the trial Court heard the testimony of both Toulmin and Swarthout and observed the demeanor of both authors on the stand, is the trial Court's finding that:

> "The clear facts and the only possible inferences that can reasonably be drawn from them establishes beyond possibility that this case is a clear case of *de minimis*." (Fdg. 21, Petit. p. 12).

The Court of Appeals for the Sixth Circuit, after Briefs and argument before it by counsel, affirmed in a *per curiam* decision. (Petit. p. 13).

## ARGUMENT

It is respectfully submitted that on these facts, which are uncontested, each of the following reasons, considered separately, is a complete basis for denial of certiorari:

1. The decision is clearly right on the merits as to fair use: the quotation meets all the customary standards by which fair use is measured by the Courts and there are no reasonable inferences to the contrary. Applicable authorities are set out in Appendix I hereto, p. 10 infra.
2. Equally clearly, the decision is right on the merits as to *de minimis*. Plaintiff recognized that "... interest in (the *Pershing* book) has long since been exhausted. . .", and the book had been out of print for twenty-two years without intention to reissue or republish it. The copyright owner gave no indication at all that it considered there had been an infringement, and plaintiff obtained the purported assignment on the representations that it was essentially valueless, and that he wanted it "... for sentimental reasons." He accepted the assignment from a com-

pany not the owner of record and made no attempt to connect his actual assignor with the owner of record. He then promptly filed suit against a local Dayton retailer and a distributor whose combined total sales were only a few hundred dollars. Two courts have decided these circumstances are *de minimis* and we submit they could not properly have held otherwise.

3. The first full paragraph on page 4 of the Petition raises a spurious issue by misstating first the doctrine of fair use and then that of *de minimis*. Fair use does include direct quotations (Auth. in Appdx. II, infra p. 11), from which it follows that it is not inconsistent with *de minimis*. The Courts below treated the doctrines properly as cumulative.

4. All other reasons aside, the decision was plainly right because of plaintiff's total failure to show he owned the copyright. There is a clear break in the chain of title.

5. Infringement is a tort, and whether or not it was committed is a question of fact. Two courts have decided this question for defendants. The facts here are not challenged: the evidence of both plaintiff and defendant was consistent and uncontradicted. Plaintiff has not cited any decision indicating an error of law: to the extent that it is applicable, the only decision he does cite is authority for defendants.

6. Not a single consideration under Rule 19 indicating desirability of certiorari is present. The Court of Appeals decision is not in conflict with the decision of any other Court. It does not decide an important question of Federal law which has not been, but should be, settled by this Court: this Court has long since settled the basic proposition of copyright law that to constitute infringement there must

be copying of a portion substantial in substance, or extent, or both, and neither criterion is met by the facts here. The Court of Appeals did not decide the question here in a way in conflict with applicable decisions of this Court, but in accordance with them. And certainly there has been no departure from the accepted and usual course of judicial proceedings; the District Court gave full and careful consideration to the evidence and law, and the Court of Appeals decision similarly was made after full briefing and oral argument.

The number of errors and misstatements in the Petition is such that they should not go unnoted. They are set out in Appendix II hereto (p. 11 infra.)

## CONCLUSION

Plaintiff's position, it is submitted, is conspicuously lacking in equity. It is respectfully requested that the Petition be denied.

Respectfully submitted,

THE RIKE-KUMLER COMPANY and
MIAMI VALLEY NEWS AGENCY, INC.

By LAWRENCE B. BIEBEL
Attorney for Respondents

OF COUNSEL:

Marechal, Biebel, French & Bugg
Dailey L. Bugg
Winters Bank Building
Dayton 2, Ohio.

## RESPONDENTS' APPENDIX I

Authorities on Fair Use

Court Decisions:

*Bloom & Hamlin* v. *Nixon*, 125 Fed. 977. E.D. Pa., 1903.

*Broadway Music Corporation* v. *E-R Publ. Co.*, 31 F. Supp. 817, 818, S.D. N.Y., 1940.

*Columbia Pictures Corp.* v. *National Broadcasting Co.*, 137 F. Supp. 348, 353, S.D. Cal. 1955.

*Dymow* v. *Bolton*, 11 F.2d 690, 691, 2nd Cir. 1926.

*Eggers* v. *Sun Sales Corporation*, 263 Fed. 373, 2nd Cir. 1920.

*Eisenschiml* v. *Fawcett Publications*, 246 F.2d 598, 603, 7th Cir. 1957, c.d. 355 U.S. 907.

*Green* v. *Minzensheimer*, 177 Fed. 286, S.D.N.Y., 1909.

*Harold Lloyd Corporation* v. *Witmer*, 65 F. 2d 1, 4, 9th Cir. 1933, dismissed 296 U.S. 699.

*Hill* v. *Whalen & Martell, Inc.*, 220 Fed. 359, S.D.N.Y. 1914.

*Karll* v. *Curtis Publ. Co.*, 39 F. Supp. 836, 837, E.D. Wis., 1941.

*Kustoff* v. *Chaplin*, 120 F. 2d 551, 560, 9th Cir. 1949, and auth. cited.

*Mathews Conveyor Co.* v. *Palmer-Bee Co.*, 135 F. 2d 73, 84, 85, 6th Cir. 1943.

*Perris* v. *Hexamer*, 99 U.S. 674, 675-6, U.S.S.C. 1879.

*Shapiro, Bernstein & Co., Inc.* v. *Collier & Sons Co.*, 26 USPQ 40, 43, S.D.N.Y. 1934 (not offic. reptd.)

*Tralins* v. *Kaiser Aluminum & Chemical Corp.*, 160 F. Supp. 511, 515, D.Md., 1958.

Other Authorities:

18 *Corpus Juris Secundum*, p. 219.

Amdur, *Copyright Law and Practice*, Chap. 22, p. 754 ff.

Ball, *Law of Copyright and Literary Property*, Chap. XI, pp. 259 ff.

Drone, *Copyright*, p. 414.

Howell's *Copyright Law* (Latman Revision) pp. 151 ff.

Shafter, *Musical Copyright* (2nd. ed.), pp. 240 ff.

Weil, *American Copyright Law*, pp. 429 ff.

## RESPONDENTS' APPENDIX II

Errors and misstatements appearing in the Petition, at the following pages:

p. 1. Plaintiff's Appendix does not set out the provisions of 28 U.S.C.A. 1254, but portions of annotations Nos. 1, 2, 3 and 6 thereto appearing at pages 44-46 of the 1949 edition of 28 U.S.C.A., §§ 1251-1330 inclusive. The only pertinent section is 28 U.S.C.A. 1254, sub-division 1, which is:

> § 1254. Courts of appeals; certiorari; appeal; certified questions
>
> Cases in the courts of appeals may be reviewed by the Supreme Court by the following methods:
>
> (1) By writ of certiorari granted upon the petition of any party to any civil or criminal case, before or after rendition of judgment or decree;

pp. 2, 4, 7. From the proceedings in both Courts below, it is self-evident that they applied the doctrine of *de minimis*, not with respect to the amount of material copied, as the Petition states, but as their respective evaluations of the trifling nature of plaintiff's alleged cause of action—we submit by reason

of the propriety of Swarthout's actions as a later author referring to an earlier historical account, of plaintiff's own practices as an author, and of the circumstances under which plaintiff purported to acquire the right to sue.

pp. 2-4 Plaintiff's ostensible summary of the presently applicable law misstates each proposition. Flatly contrary to the Petition, the decisions and the text writers, cited under the foregoing Appendix, are that "Copying of a SUBSTANTIAL portion is essential. . . . for infringement of a copyright." (Emph. in orig.) (*Kutsoff*, supra, 560); that "The test. . . . is not primarily a quantitative one. The question is one of quality rather than quantity (etc.)" (*Columbia Pictures Corp.*, supra, 353), and that ". . . a substantial copy of the whole, or a material part, must be reproduced. . . On the principle of de minimis non curat lex, it is necessary that a substantial part of the copyrighted work be taken." (*Mathews Conveyor*, supra, 84). There is no contrary authority.

p. 3 We find the somewhat surprising statement that the Court has made ". . . few, if any, decisions on the subject of copyright infringement, since . . . 1878. . . ." (Petit. p. 3). The Court's decision in *Perris v. Hexamer* was in fact decided on the basis that "The defendant has not copied (plaintiff's) maps" (p. 676), i.e., which is a qualitative and not a quantitative basis.

p. 3 Swarthout did not admit, but denied, that the quoted material was of any importance, and as to "leavening" "the entire content of (*Cordura*)", the District Court held that the material ". . . had no effect whatsoever on the acceptance" of that book, (Fdg. 19, Petit. p. 12).

p. 4 Contrary to the Petition, fair use is not limited to general themes, but extends to direct quotation, as matters both of clear authority:

*Bloom & Hamlin* v. *Nixon*, 125 Fed. 977. E.D. Pa., 1903.

*Broadway Music Corporation* v. *F-R Publ. Co.*, 31 F. Supp. 817, 818, S.D. N.Y., 1940.

*Eisenschiml* v. *Fawcett Publications*, 246 F.2d 598, 603, 7th Cir. 1957, c.d. 355 U.S. 907.

*Green* v. *Minzensheimer*, 177 Fed. 286, S.D.N.Y. 1909.

*Shapiro, Bernstein & Co., Inc.* v. *Collier & Sons Co.*, 26 USPQ 40, 43, S.D.N.Y. 1934 (not offic. reptd.)

and of common practice in everyday experience.

p. 4. Also contrary to the Petition, as to the qualitative content of the material quoted the District Court, affirmed by the Court of Appeals, specifically held that the quoted portion was "neither . . . substantial nor material" and was ". . . insignificant in value and extent (of *Pershing*)" and that it "did not relate to (the) theme (of the Toulmin book) at all." It held correspondingly that such portion had "no effect whatsoever on the acceptance or sale of (*Cordura*)". (Fdgs. 18.)

p. 6. The second full paragraph is grossly misleading. In his Foreword, Swarthout stated that he was quoting from "One officer, writing twenty years later" and used quotation marks to show the portion quoted. Contrary to the Petition, the trial Court flatly found that:

> "The sentences used had no effect whatsoever on the acceptance or sale of the 'Cordura' book. . . ."

(Fdg. 19, Petition p. 12).